



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/256,192 02/24/99 YASUDA M 2165.6

005514 WM02/1106
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

EXAMINER

NGUYEN, K

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 11/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/256,192

Applicant(s)

YASUDA, MICHYUKI

Examiner

Kevin M. Nguyen

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 10/24/2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/256,192 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 9, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Okutsu (US 4,288,936).**

As to claims 9 and 10, Okutsu teaches a magnetic display device 1 which includes two transparent or semi-transparent substrates 9 and 10 being disposed confronting one another as shown in Fig. 4 so as to form a space in which liquid can be enclosed and a multi-cell structure 11 having a number of cells is provided in the liquid enclosing space. Enclosed in the cells is a dispersed liquid 12 composed of a thickener, magnetic particles, a coloring agent and a dispersing medium (see col. 6, lines 25-33), the dispersed liquid in which the magnetic particles are dispersed, and to color the dispersed liquid, thereby to increase the color contrast between a display formed by the magnetic particles and the background, a coloring agent selected from the group of white pigment, yellow pigment and other such dyes or pigments is added to the

dispersed liquid (see col. 4, lines 37-44). Okutsu teaches inherently the image being visible through the upper transparent flat-sheet member 9, whereby when the image disappears the magnetic settle downward away from upper transparent white pigments exhibit a white display, and when the image appear the magnetic particles migrate upward towards the upper transparent flat-sheet member, the image being formed by a metallic luster color exhibited by mixture of appearance of the migrate magnetic particles with the luster (when magnetic force is exerted on the dispersed liquid 12 with the displaying magnet 8, the magnetic particles are moved as a result of which a figure such as for instance a block figure on a white background which is clear and high in contrast and tone can be displayed, see col. 6, lines 25-38).

As to claim 12, Okutsu teaches inherently two transparent or semi-transparent substrates 9 and 10 being a transparent non-magnetic layer and a luster layer (transparent layer) having luster selected from iridescent luster as claimed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okutsu (US 4,288,936) in view of Ohashi et al (US 5,674,104).

As to claims 11 and 14, Okutsu teaches all of the claimed limitations of claim 10, except for the microcapsules fixed between the upper flat-sheet member and the lower flat-sheet member. However, Ohashi teaches a related magnetic display having the magnetic display sheet 32 comprising a plurality of sandwiched microcapsules 33 (see col. 3, lines 34-42). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the microcapsules taught by Ohashi et al in the magnetic display of Okutsu's system because of it is understand that it is understood that the principles of the present invention are not limited to the preferred embodiment. Various modifications are possible without departing from the scope of the present invention (see col. 5, lines 51-54 of Ohashi et al).

As to claim 13, Okutsu teaches inherently two transparent or semi-transparent substrates 9 and 10 being a transparent non-magnetic layer and a luster layer (transparent layer) having luster selected from iridescent luster as claimed.

Response to Arguments

7. Applicant's arguments filed 10/24/2001 have been fully considered but they are not persuasive.

In response to applicant's argument that claims 9 and 10 recite "whereby when the image disappears the magnetic settle downward away from upper transparent white pigments exhibit a white display, and when the image appear the magnetic particles migrate upward towards the upper transparent flat-sheet member, the image being formed by a metallic luster color exhibited by mixture of appearance of the migrate magnetic particles with the luster." This argument is not persuasive because Okutsu's invention teaches "magnetic particles, a coloring agent and a dispersing medium; the dispersed liquid in which the magnetic particles are dispersed, and to color the dispersed liquid, thereby to increase the color contrast between a display formed by the magnetic particles and the background, a coloring agent selected from the group of white pigment, yellow pigment and other such dyes or pigments is added to the dispersed liquid; when magnetic force is exerted on the dispersed liquid 12 with the displaying magnet 8, the magnetic particles are moved as a result of which a figure such as for instance a block figure on a white background which is clear and high in contrast and tone can be displayed." These arguments are not persuasive because it would have been obvious to a person of ordinary skill in the art at the time of the invention to recognize that Magnetic points out the display devices which are well known in the art, and include a display sheet consisting of a plurality of microcapsules containing oily liquid having photoabsorptive, ferromagnetic powder and photorefective, non-magnetic powder mixed therewith (see col. 1, lines 9-13 of Ohashi et al).

8. Applicant's arguments with respect to claims 9-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 form.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kevin M. Nguyen** whose telephone number is **703-305-6209**. The examiner can normally be reached on M-F (9:00-5:00), with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Richard Hjerpe** can be reached on **703-305-4709**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

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Kevin M. Nguyen
Examiner
Art Unit 2674

KN
November 2, 2001

A handwritten signature in black ink, appearing to read 'Richard Hjerpe', with a stylized, cursive script.

RICHARD HJERPE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600